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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,096	05/04/2001	Olav Solgaard	UC97-156-8	1934

7590 08/29/2003

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EXAMINER

LEE, JOHN D

ART UNIT PAPER NUMBER

2874

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/849,096

Applicant(s)

SOLGAARD ET AL.

Examiner

John D. Lee

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-33, 37-43 and 47-50 is/are allowed.
- 6) ☒ Claim(s) 34-36, 44-46 and 51-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9-12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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This Office action follows the "Decision On Petition To Withdraw Holding Of Abandonment", mailed August 1, 2003. The abandonment of this application has been withdrawn and is now subject to further examination. The response to the previous Office action (the response having been given a date of May 13, 2002) has been considered, as have the prior art documents filed on the following dates: May 6, 2002; May 22, 2002; August 28, 2002; September 5, 2002; and February 19, 2003. In view of all such consideration, the previously established determination of patentability of the claims is hereby modified as set forth further below. This action is **not** made final.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

Claims 34-36, 44-46, and 51-64 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 98-101, 123-126, and 62-76 of copending Application No. 09/813,446. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The correspondence of the claims is set forth in the following chart. Note that the scope of the corresponding claims is identical; the only differences are in the use of the words "an" and "any" which does not change the meaning and scope.

<u>Serial Number 09/849,096</u>	<u>Serial Number 09/813,446</u>
Claim.....34	Claim.....101
35	98-100
36	101
44	126
45	123-125
46	126
51	62-64
52	62-64
53	65
54	66
55	67
56	68
57	69
58	70
59	71
60	72
61	73
62	74
63	75
64	76

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-64 are further rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Japanese Published Patent Disclosure No. 5-107485 to Kunio et al (submitted by applicant). Note that the publication date of this Disclosure is April 30, 1993. Kunio et al discloses an optical switch comprising a pair of facing two-dimensional arrays of actuated mirrors which can be configured for switching an optical beam from any input port on either array to any output port on either array. Since each

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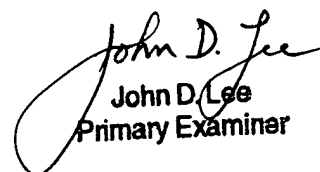
mirror in the Kunio et al arrays is individually addressable, the switch can be configured to have a specific mirror to receive an optical beam from a corresponding one specific input port, or to have a specific output port receive an optical beam from a corresponding one specific mirror in the array. Kunio et al further discloses lenses for positioning optical beams onto the arrays of actuated mirrors.

Claims 31-33, 37-43, and 47-50 are allowed. The reasons for allowability have been developed previously during the prosecution of this application.

Applicant's arguments with respect to the claims rejected above have been considered but are moot in view of the new ground(s) of rejection.

All of the prior art documents submitted by applicant in the Information Disclosure Statements filed on May 6, 2002, May 22, 2002, August 28, 2002, September 5, 2002, and February 19, 2003, have been considered and made of record (note the attached copy of forms PTO-1449).

Any inquiry concerning the merits of this communication should be directed to Examiner John D. Lee at telephone number (703) 308-4886. The Examiner's normal work schedule is Tuesday through Friday, 6:30 AM to 5:00 PM. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956, to the technical support staff supervisor (Team 2) at telephone number (703) 308-3072, or to the Technology Center 2800 Customer Service Office at telephone number (703) 306-3329.

  
John D. Lee  
Primary Examiner